

1773



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants : Miladin P. Lazarov et al.
 Serial No. : 09/521,086
 Filed : March 7, 2000
 Title : BIOCOMPATIBLE ARTICLE

Art Unit : 1773
 Examiner : C. Paulraj

Commissioner for Patents
 Washington, D.C. 20231

RECEIVED
APR - 6 2001
TECHNOLOGY CENTER 2000
U.S. PATENT & TRADEMARK OFFICE

RESPONSE TO RESTRICTION REQUIREMENT

Responsive to the action mailed February 22, 2001, applicant elects the invention of Group I which includes claims 1-11 and 17-19. The election is made with traverse.

The article and method claims 1 and 12 are both based on the identity of the constituents of the layers. It is submitted that a full search of the elected Group I claims should in fact cover the same ground needed to be covered in connection with the method claim 12. Moreover, if the claimed article is not found to be anticipated or obvious from the prior art, then a method which requires application of the same constituent layers would automatically be patentable. The process and article claims are further interrelated by the presence of the following claim limitation in the sole independent method claim 12, namely "*a process for producing an article as claimed in any of the preceding claims,*" which of course are article claims. Further, the German priority application, which includes similar claims, has apparently been examined without objection based on unity of invention. The prior art developed in that examination will be forwarded shortly.

Finally, applicants note that the restriction requirement is not supported by any suggestion of undue examining burden or the need to assign the method claims to a different examiner in a different art unit. Indeed, it appears that the scope of competency of the assigned art unit embraces both the article in this case and the method by which it is made.

CERTIFICATE OF MAILING BY FIRST CLASS MAIL

I hereby certify under 37 CFR §1.8(a) that this correspondence is being deposited with the United States Postal Service as first class mail with sufficient postage on the date indicated below and is addressed to the Commissioner for Patents, Washington, D.C. 20231.

March 22, 2001
 Date of Deposit

T. Bagay
 Signature

Tabitha B. Gray
 Typed or Printed Name of Person Signing Certificate

Applicant : Miladin P. Lazaro
Serial No. : 09/521,086
Filed : March 7, 2000
Page : 2

Atto [REDACTED]'s Docket No.: 11699-002001

In light of the close connection between the article and method claims here, and the possibility of multiple United States patents issuing unnecessarily, with requirements for consistent prosecution, and extra fees, etc., applicants urge reconsideration and withdrawal of the requirement for restriction and request that all of the claims be searched and examined together for the sake of efficiency.

Please apply any charges or credits to Deposit Account No. 06-1050, referencing attorney docket number 11699-002001.

Respectfully submitted,

Date: March 22, 2001

Gilbert H. Hennessey
Gilbert H. Hennessey
Reg. No. 25,759

Fish & Richardson P.C.
225 Franklin Street
Boston, MA 02110-2804
Telephone: (617) 542-5070
Facsimile: (617) 542-8906

20194031.doc